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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,805	09/29/2000	Joseph R. Stonoha	632.0001USU	2958

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Charles N.J. Ruggiero, Esq.
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
10th Floor
One Landmark Square
Stamford, CT 06901-2682

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,805

Applicant(s)

STONOH A ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.
 - 2.1 The oath or declaration is defective because:
 - A) it fails to claim the benefit of provisional application number 60/178036 as stated in the first paragraph on page 1.
3. The drawings are objected to because
 - A) the following errors have been noted in the drawings:
 - (1) fig. 11 lacks the "Y" legend for step 304 as described in the paragraph at page 13, lines 4-13, "If step 304 determines ... for a label template to be selected."
 - (2) fig. 12 lacks the "Y" and "N" legends for step 342 as described in the paragraph between page 13, line 23, and page 14, line 8, "Referring to FIG. 12, ... which is in FIG. 13."
 - (3) fig. 13 lacks the "Y" and "N" legends for steps 356 & 360 as described in the paragraphs at page 14, lines 9-30, "Referring to FIG. 13, ... which is continued in FIG. 17."
 - (4) when comparing fig. 16 to the disclosure in the paragraph at page 16, lines 3-17, "Referring to FIG. 16, ... that is continued in FIG. 17.", it can be seen that fig. 16 does not correspond to its description in regard to steps 430, 432, 434, 436, 438 & 440, since it appears that at least the "YES" and "NO" legends have possibly been reversed.

(5) fig. 17 lacks the "Y" legends for steps 452 & 464 as described in the paragraph between page 16, line 18, and page 17, line 3, "Referring to FIG. 17, ... to print the labels of the label job."

3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

4. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 148, 150, 152, 182 & 186 of fig. 8 in the paragraphs between page 10, line 16, and page 11, line 13, "Referring to FIG. 8 ... to be placed in a data file.

(2) how the program proceeds after box(es):

(a) 338 of fig. 12 if the inquiry is "NO" as described in the paragraph between page 13, line 23, and page 14, line 8, "Referring to FIG. 12, ... which is in FIG. 13.";

(b) 360 of fig. 13 if the inquiry is "YES" as described in the paragraph at page 14, lines 9-30, "Referring to FIG. 13, ... which is continued in FIG. 17.";

(c) 406 of fig. 14 if the inquiry is "NO" as described in the paragraph at page 15, lines 1-20, "Referring to FIG. 14, ... which is continued in FIG. 15.";

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(d) 426 of fig. 15 if the inquiry is "NO" as described in the paragraph between page 15, line 21, and page 16, line 2, "Referring to FIG. 15, ... that is continued in FIG. 16.";

(e) 438 of fig. 16 if the inquiry is "NO" as described in the paragraph at page 16, lines 3-17, "Referring to FIG. 16, ... that is continued in FIG. 17."; and

(f) 464 of fig. 17 if the inquiry is "YES" as described in the paragraph between page 16, line 18, and page 17, line 3, "Referring to FIG. 17, ... to print the labels of the label job.";

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 5-9, 14-18, 24-27, 38, 39, 48 & 49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 Claim 5 is confusing since this claim lacks a limitation (d). In this regard it is noted that claim 5 recites an additional limitation (e), however claim 5 is directly dependent from claim 1 which only recites limitations (a), (b) & (c), therefore it is unclear and confusing what happen to limitation (d).

6.1.1 Claims 6-9 are confusing in relation to claim 1 for the same reason set forth in regard to claims 1 and 5.

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6.1.2 Claims 14-18 are confusing in relation to claim 10 for the same reason set forth in regard to claims 1 and 5.

6.1.3 Claims 14-27 are confusing in relation to claim 19 for the same reason set forth in regard to claims 1 and 5, it is noted that these claims refer to numerically designated means that skip sequential designations.

6.1.4 Claims 38 & 39 are confusing in relation to claim 28 for the same reason set forth in regard to claims 1 and 5, it is noted that these claims refer to numerically designated entries that skip sequential designations.

6.1.5 Claim 48 is confusing in relation to claim 39 for the same reason set forth in regard to claims 1 and 5.

6.1.6 Claim 49 is confusing in relation to claim 46 for the same reason set forth in regard to claims 1 and 5.

6.1.7 Claims 59 & 60 are confusing in relation to claim 50 for the same reason set forth in regard to claims 1 and 5, it is noted that these claims refer to numerically designated means that skip sequential designations.

6.2 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.1 Claims 1-7, 9-16, 18-25 & 27-60 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Drisko (4,718,784).

7.1.1 In regard to claims 1, 5-7, 9, 10, 14-16, 18-25, 27-37, 39, 41, 42, 45-48, 50, 52, 53 & 56-59, Drisko ('784) discloses a computer system for designing and printing labels. In the system of Drisko ('784) a processor under a control program stored in a memory operates the system the system to Drisko ('784) to permit the user to use a input means to make various

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entries of data into the system and to display the entered data. Where the various entries of data include the designation of:

- A) the location/position of text and/or graphics that is to appear on the label;
- B) the content of the text and/or graphics that is to appear on the label;
- C) the size of the label;
- D) the font size and appearance, e.g. bold type;
- E) whether or not a barcode is to appear on the label;
- F) the arrangement of the blank labels on the print stock; and
- G) a designation of the labels to be printed.

It is further noted that for each label to be generated, the user may select either previously defined label designs or create custom labels, hence, consecutive labels may not be related to one another.

7.1.2 Once the labels have been designed, the user may then instruct the processor to print the labels on blank label stock.

7.1.3 In regard to claims 2-4, 11-13, 40, 43, 44, 51, 54 & 55, it is noted that applicant has failed to define the exact nature of the "palette", hence this word is given its common ordinary meaning. In view of this one of ordinary skill would know that it is common practice to set forth to the user various options by presenting to the user a palette or a display showing a number of possible positions/colors/fonts available to the user. The user then would select the desired item from one of the available palettes. Note for example a color palette or a graphics palette or a font palette or a palette of label designs.

7.1.4 In regard to claim 38, 49 & 60, the system of Drisko ('784) further keeps track of the number of labels printed and assigns consecutive serial numbers to each label if the user has designated this feature.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 8, 17, 26 & 61-69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drisko (4,718,784) as applied above to claims 1-7, 9-16, 18-25 & 27-60 and further in view of an obvious variations.

8.1.1 It is noted in regard to claims 8, 17 & 26, that Drisko ('784) does not permit the user to designate a rotational orientation for the barcode, however, Drisko ('784) does permit the user to define the exact location on the barcode on the label relative to the other information on the label. Since the teachings of Drisko ('784) permit the user of Drisko ('784) could define a position and orientation for the barcode which is rotated from the position and orientation of the remaining information by not excluding this possibility, it would have been obvious to one of ordinary skill at the item the invention was made that the system of Drisko ('784) does permit the user to define a rotational orientation for the barcode and/or text that is to appear on the label.

8.1.2 It is noted in regard to claims 60-69, that Drisko ('784) does not permit the user to designate a warning level to alert the user of a low supply of labels, however, Drisko ('784) does track the number of labels generated during printing. Further it would have been clear to a skilled artisan that it is not desirable to start a print job that could not be completed because of a low supply of labels would affect other systems and potentially cause problems for the user. Since, the teachings of Drisko ('784) do in fact track the number of labels printed, it would have been obvious to one of ordinary skill at the item the invention was made that the system of Drisko ('784) could be modified to use alterable alert levels so as to prevent

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unnecessary interruption during the production of a label print job, since such interruption would affect associated system and may cause problems for the user.

9. The examiner has cited prior art of interest, for example:

A) either the Newsbytes article, Price et al (4,939,674) or Ogura et al (EP 0574657 A2), or Kawamoto, or Benade et al (5,621,864), or Automatic I.D. News article, or Spain (6,056,195), all of which disclose computer system that allows an user to design and print color labels.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

07/01/03


Edward R. Cosimano
Primary Examiner A.U. 3629